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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,762	07/05/2001	Dale Francis Obeshaw	DP-300402	4583

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EXAMINER

ZIMMERMAN, JOHN J

ART UNIT	PAPER NUMBER
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1775

DATE MAILED: 05/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/900,762

Applicant(s)

OBESHAU, DALE FRANCIS

Examiner

John J. Zimmerman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

FOURTH OFFICE ACTION

Amendments

1. This Office Action is in response to the Amendment and Request for Reconsideration received December 23, 2003. Claims 1-39 are pending in this application.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of U.S. Patent No. 6,586,110 in view of applicant's disclosure of the prior art. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent and the claims of this application both claim a contoured structural member having a continuous plurality of contoured

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metal-containing layers in an inner section and an outer section and further having and an intermediate section of a ribbed structure. Although it is noted that the claims of this application also may cover "composite material" layers (e.g. claim 1, lines 3 and 5), this is only an alternative embodiment and the other alternative "metal-containing material" embodiment (e.g. claim 1, lines 3 and 5) overlaps the scope of the claims of the patent. There is no patentable distinction between the two sets of claims. Although it is noted that some claims of this application require that the structural member be in a "substantially non-straight" configuration, in view of the fact that the structural members of the patent and this application are designed to be parts of larger structures, it would have been obvious to one of ordinary skill in the art at the time the invention was made to configure the structures in non-straight configurations. In the particular art to which applicant's structures belong, applicant discloses various examples (see Background of the Invention, pages 2-4; e.g. U.S. 5,848,767; U.S. 5,652,039; U.S. 5,195,779; U.S. 5,140,913, etc. . .) of typical structures and uses. These structures clearly show that conventional structures in the relevant prior art are indeed typically configured in non-straight configurations. Therefore, this further provides evidence of the level of ordinary skill in the art at the time the invention was made and also provides support for the position that using non-straight configurations would be considered an obvious alternative form for structures of the types claimed and would not be considered separate or patentably distinct inventions. One must consider the level of ordinary skill in the relevant art when evaluating obviousness. It is axiomatic that consideration of the prior art cited by the examiner must, of necessity, include consideration of the admitted state of the art found in applicant's specification, *In re Davis*, 305 F.2d 501, 134 USPQ 256 (CCPA 1962); *In re Hedges*, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir.

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1986). Admitted knowledge in the prior art may be used in determining patentability of the claimed subject matter, *In re Nomiya*, 509 F.2d 566, 184 USPQ 607 (CCPA 1975).

4. Claims 1-39 are provisionally rejected under the judicially created doctrine of obviousness type double patenting over claims 1-15, 17-31, 33-34, 36-38 and 40-42 of copending Application No. 09/898,519 in view of applicant's disclosure of the prior art. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of both applications claim a contoured structural member having a continuous plurality of contoured metal-containing layers in an inner section and an outer section and further having and an intermediate section of a ribbed structure. Although it is noted that the claims of the copending application now recite "a structural component", each section of the contoured structural members of the claims of both applications qualify as a "structural component" and therefore there is no patentable distinction in this limitation. In any event, some claims (e.g. claim 17) of this application specify further structural components. Also, since the contoured structural members of the two sets of claims are designed as parts to be incorporated into other components, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add structural components to the contoured structural members to attach them or incorporate them into other larger structures. Indeed, applicant's description of the related art in the "Background of the Invention" section of the specification (see the figures in the cited patents) shows that the this adding structural components is typical in the relevant art. One must consider the level of ordinary skill in the relevant art when evaluating obviousness. It is axiomatic that consideration of the prior art cited by the examiner must, of necessity, include

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consideration of the admitted state of the art found in applicant's specification, *In re Davis*, 305 F.2d 501, 134 USPQ 256 (CCPA 1962); *In re Hedges*, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986). Admitted knowledge in the prior art may be used in determining patentability of the claimed subject matter, *In re Nomiya*, 509 F.2d 566, 184 USPQ 607 (CCPA 1975). This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 1-39 are provisionally rejected under the judicially created doctrine of obviousness type double patenting over claims 1-38 of copending Application No. 09/899,320 in view of applicant's disclosure of the prior art. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of both applications claim a contoured structural member having a continuous plurality of contoured metal-containing layers in an inner section and an outer section and further having and an intermediate section of a ribbed structure. Although it is noted that some claims of this application require that the structural member be in a "substantially non-straight" configuration, in view of the fact that the structural members of the patent and this application are designed to be parts of larger structures, it would have been obvious to one of ordinary skill in the art at the time the invention was made to configure the structures in non-straight configurations. In the particular art to which applicant's structures belong, applicant discloses various examples (see Background of the Invention, pages 2-4; e.g. U.S. 5,848,767; U.S. 5,652,039; U.S. 5,195,779; U.S. 5,140,913, etc. . .) of typical structures and uses. These structures clearly show that conventional structures in the relevant prior art are indeed typically configured in non-straight configurations. Therefore, this

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further provides evidence of the level of ordinary skill in the art at the time the invention was made and also provides support for the position that using non-straight configurations would be considered an obvious alternative form for structures of the types claimed and would not be considered separate or patentably distinct inventions. One must consider the level of ordinary skill in the relevant art when evaluating obviousness. It is axiomatic that consideration of the prior art cited by the examiner must, of necessity, include consideration of the admitted state of the art found in applicant's specification, *In re Davis*, 305 F.2d 501, 134 USPQ 256 (CCPA 1962); *In re Hedges*, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986). Admitted knowledge in the prior art may be used in determining patentability of the claimed subject matter, *In re Nomiya*, 509 F.2d 566, 184 USPQ 607 (CCPA 1975). Although it is also noted that claims of the copending application recite "a coating", the examiner notes that coatings (e.g. painting, corrosion proofing, wear proofing, improving aesthetics) are typically applied to structural members and there is no patentable distinction in simply applying coatings to the contoured structural members. It would have been obvious to one ordinary skill in the art at time the invention was made to apply a coating to the structural member of the claims of this application (e.g. for aesthetics, corrosion resistance, weather proofing, etc. . .). This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

7. Claims 7, 10-13, 15, 17 and 36-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Layte (U.S. Patent 2,816,665).

8. Layte discloses a contoured structural member having a continuous plurality of contoured metal-containing layers in an inner section (any of the plurality of inner layers of the article shown in Figure 5) and an outer section (any of the plurality of outer layers of the article shown in Figure 5) and further having and an intermediate section of a ribbed structure (any of the intermediate layers shown in Figure 5). Although it is noted that Layte's inner and outer sections also contain rib structures, the pending claims do not prohibit rib structures in the inner and outer sections. While it is noted that Layte's article is formed from a single wound sheet, the pending claims do not prohibit forming the inner, outer and intermediate sections from single long sheets. Layte shows a further "structural component" attached to the article in Figures 7 (end caps) and Figure 8. Regarding claims reciting an "initiator", any discontinuity in the article (e.g. the holes, ribs, etc. . .) may function as an initiator. Layte forms his structural member by rolling the sections about a mandrel (e.g. see column 2, lines 43-54). Regarding article claims reciting

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method steps, Layte may not disclose the same process steps, but these claims are product claims and not process claims. When there is a substantially similar product, as in the applied prior art, the burden of proof is shifted to the applicant to establish that their product is patentably distinct not the examiner to show that the same process of making, see *In re Brown*, 173 U.S.P.Q 685, and *In re Fessmann*, 180 U.S.P.Q. 324. Particularly note that in article claims 38 and 39 reciting a method wherein the shrink wrap is added *and* removed, the shrink wrap would not be present in the claimed final article.

Response to Arguments

9. Applicant's arguments filed December 23, 2003 have been fully considered but they are not persuasive with regards to the remaining rejections. Claims 7, 10-13, 15, 17 and 36-39 remain rejected under 35 U.S.C. 102(b) as being anticipated by Layte (U.S. Patent 2,816,665). Applicant argues that Layte does not disclose a "substantially non-straight structural member". The examiner notes that Layte's filter is radial and the article clearly is not "straight" in Figure 5. Applicant's argues as if the pending claims require that the structural member is not straight in the "longitudinal" direction, but there is no such limitation in the claims.

10. Regarding the rejection of claims 1-39 under the judicially created doctrine of obviousness-type double patenting, the pending rejections clearly show that the variations of the claims of the current application, the patent and the copending applications are obvious variations to one of ordinary skill in the art at the time the invention was made. The examiner

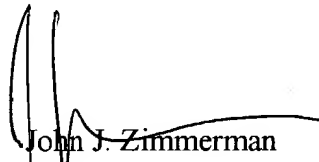
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has established the level of ordinary skill in the art in the rejections. In view of the new rejections, this Office Action has not been made Final.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Zimmerman whose telephone number is (571) 272-1547. The examiner can normally be reached on 8:30am-5:00pm, M-F. Supervisor Deborah Jones can be reached on (571) 272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


John J. Zimmerman
Primary Examiner
Art Unit 1775

jjz
April 29, 2004